

REMARKS/ ARGUMENTS

The Office Action of July 14, 2004 has been carefully reviewed and this response addresses the Examiner's concerns.

Status of the Claims

Claims 1, 3-7, 9-13, 15-23 were pending in this application.

Claims 2, 8, and 14 were cancelled without prejudice.

Claims 1, 3-7, 9-13, and 15-23 were rejected.

Claims 1, 3-7, 9-13, and 15-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner et al. 4,931,959.

Claims 1, 3, 7, 9, 13, and 15 are amended.

Claims 10, 16, 19, 21, 23 are cancelled without prejudice.

Support in the Specification to Amendments to Claims 1 3, 7, 9, 13, and 15

The amendments to the claims do not raise new issues or require additional search. The amended limitation of claims 1, 3, 7, 9, 13, and 15 was, previous to the amendment, expressed in means plus function form (limitations according to 35 USC 112, Sixth paragraph, MPEP 2181). The structures in the specification that accomplish the claimed function are described in paragraph 101, pages 29-30 and Figure 16 (first structure), in paragraph 103, page 30 and Figure 17 (second structure), paragraphs 104 and 105, page 31 and Figure 18 (third structure), and paragraph 106, pages 31-32 and Figure 19 (fourth embodiment). The description of the way in which the means for rearranging spatial components of an object located proximate the input plane operate is given in paragraphs 35-58, pages 8-15. The amendments recite the structure that accomplish the claimed function, namely, at least two refractive or diffractive surfaces used for said rearranging of said spatial components of said object (paragraph 35, line 6-8 in the specification), each of said at least two surfaces being inclined with respect to said output plane and being proximate one of said planes (paragraph 35, lines 12-13, paragraph 40, lines 1-3). 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure described in the specification and equivalents thereof." (MPEP 2181). Since the present amendments make explicit that which was included by the statutory claim construction, the present amendments to the claims do not raise new issues or require additional search.

The 35 U.S.C. §103 rejections

Claims 1, 3-7, 9-13, and 15-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner et al. 4,931,959.

Brenner (the '959 patent) discloses a structure including an "input plane 401, deflecting prisms 405 and 410, Fourier transform lens 415, deflecting prisms 420 and 425, inverse Fourier transform lens 430 and output image plane 435," shown in Fig. 4 of the '959 patent. Referring to Fig. 4 of the '959 patent, only one surface, a flat surface of the Fourier transform lens 430, is proximate to the image plane 435. The distance F2 between the flat surface of the Fourier transform lens 430 and the image plane 435 is "equal to the focal length of lens 430" (col. 4, line 37, the '959 patent). The "vertical sides of prisms 405 and 410" (col. 4, line 2, the '959 patent) are proximate, and parallel to the input plane 401. Thus, Brenner does not disclose the claimed limitation of "at least two refractive or diffractive surfaces used for said rearranging of said spatial components of said object, each of said at least two surfaces being inclined with respect to said output plane and being proximate one of said planes," present in independent claims 1, 3, 7, 9, 13, and 15 of the Applicant's claimed invention.

Furthermore, the means for rearranging spatial components disclosed in the '959 patent or disclosed in terms of macro-optics (or large format components). In the macro-optic applications of the '959 patent, modifying the imaging device in the '959 patent in order to obtain the features of the claimed present invention, would render the '959 patent inoperable for its intended functions. (As an analogy, consider the modifying of the camera by replacing the camera lens with a GRIN rod lens having the same optical properties except for the aperture size. The modified camera would be rendered inoperable for the intended purpose of taking large format pictures.)

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." MPEP 2143.01

Under a 103 rejection, a prima facie case of obviousness of the invention must be made in view of the scope and content of the prior art. In order to establish a *prima facie* case of

obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references) must teach or suggest all of the claim limitations." M.P.E.P. §2143.

Applicant respectfully asserts that the '959 patent does not contains all the limitations of amended independent Claim 1, 3, 7, 9, 13 or 15, as described in the preceding paragraphs. Furthermore, since modifying the '959 patent would render the invention set forth in the '959 patent unsatisfactory for its intended functions, there is no motivation to modify the '959 patent to meet the patentable limitations of the present invention.

In conclusion, Applicant respectfully asserts that a prima facie case of obviousness has not been established.

In conclusion, in view of the above remarks, Applicants respectfully request the Examiner to enter the amendments presented herein and find claims 1, 3-7, 9, 11-13, 15, 17-18, 20, and 22 allowable over the prior art and pass this case to issue.

Although no additional fees are deemed necessary, any required fees should be charged to Deposit Account No. 03-2410, Order No. 6536-109 and any overpayment should be credited to this account.

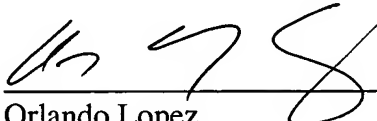
In accordance with Section 714.01 of the M.P.E.P., the following information is presented in the event that a call may be deemed desirable by the Examiner:

ORLANDO LOPEZ (617) 854-4000

Dated: November 12, 2004

Respectfully submitted,
Thomas W. Stone, Applicant

By:


Orlando Lopez
Reg. No. 46,880
Agent for Applicant